

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

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U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAMES MEEK, DONALD MCCOY, GREGORY SHIMEK,
IREK SINGER, ANTHONY LEE, KEN KORAN, WILLIAM HEMLICK,
RON DIFRANGO, CHANGNING JIANG, ROBERT D. SYMONDS,
PETER ST. GEORGE and ROBERT BRADLEY GILL

Appeal No. 2005-1625
Application No. 09/449,426¹

ON BRIEF

Before HAIRSTON, KRASS and SAADAT, Administrative Patent Judges.
SAADAT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the Examiner's final rejection of claims 1-55, which are all of the claims pending in this application.

We reverse.

¹ Application for patent filed November 24, 1999, which claims the filing priority benefit under 35 U.S.C. § 119 of the Provisional Application No. 60/110,125, filed November 27, 1998.

BACKGROUND

Appellants' invention relates to providing customer marketing messages to users of automated transaction machines such as ATM. By using information representative of the identity of the customer to a remote computer which is different from the computer which is involved in authorizing the transaction, a marketing message is returned and presented to the customer.

Representative independent claims 1 and 47 are reproduced below:

1. A method comprising the steps of:
 - (a) receiving at least one identifying input from a user at an automated transaction machine;
 - (b) receiving at least one transaction request input corresponding to a request to conduct a financial transaction from the user at the transaction machine;
 - (c) sending from the transaction machine to a first computer, a marketing request message including user data corresponding to an identifying input from the user;
 - (d) sending from the transaction machine to a second computer, a transaction request message including transaction request data corresponding to an identifying input from the user and the transaction request input;
 - (e) selecting through operation of the first computer responsive to the user data, data corresponding to a presentation to be made to the user;

- (f) sending from the first computer to the transaction machine a marketing response message including presentation data corresponding to the presentation;
- (g) determining through operation of the second computer responsive to the transaction request data, a transaction response;
- (h) sending from the second computer to the transaction machine a transaction response message including transaction response data corresponding to the transaction response;
- (i) presenting responsive to the presentation data at least one output through at least one output device in connection with the transaction machine;
- (j) carrying out the financial transaction through operation of at least one transaction function device in connection with the transaction machine responsive to the transaction response data.

47. A method comprising:

- (a) carrying out a financial transaction for a user through operation of an automated transaction machine by communicating at least one financial transaction message between the transaction machine and a first computer; and concurrently during at least a portion of the financial transaction
- (b) marketing at least one product to the user through operation of the transaction machine by communicating at least one marketing message between the transaction machine and a second computer.

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The Examiner relies on the following references in rejecting the claims:

| | <u>U.S. Patents</u> | |
|--------------------------|---------------------|---------------------------------------|
| Murphy | 5,305,195 | Apr. 19, 1994 |
| Symonds et al. (Symonds) | 6,039,245 | Mar. 21, 2000 (filed Mar. 7, 1997) |

| | <u>Published European Patent Application</u> | |
|------------------------------|--|--------------|
| Patterson et al. (Patterson) | EP 0843291 A2 | May 20, 1998 |

Claims 47, 51 and 55 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Murphy.

Claims 1-29, 31-34, 36-46, 48-50 and 52-54 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Murphy and Patterson.

Claims 30 and 35 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Murphy, Patterson and Symonds.

Rather than reiterate the opposing arguments, reference is made to the briefs and answer for the respective positions of Appellants and the Examiner. Only those arguments actually made by Appellants have been considered in this decision. Arguments which Appellants could have made but chose not to make in the briefs have not been considered (37 CFR § 41.37(c)(1)(vii)).

OPINION

With respect to the 35 U.S.C. § 102 rejection of claims 47, 51 and 55, the focus of Appellants' arguments is that in Murphy the advertising message is not determined by accessing the commercial computer while a user is waiting (brief, page 12). Appellants further assert that in fact, the advertising is stored on the terminal hard disc during the terminal down time (id.) which means that marketing a product to the user by communicating with a second computer is not done concurrently during a portion of the financial transaction (brief, page 13; reply brief, page 4).

In response to Appellants' arguments, the Examiner asserts that Murphy, as shown in Figure 1, transfers the advertisement from the marketing computer during the period the user is waiting for a response from the transaction computer (answer, page 8). The Examiner further asserts that Murphy does not store the video signals on the hard disc 18 when a co-axial cable is used (id.).

A rejection for anticipation under section 102 requires that the four corners of a single prior art document describe every element of the claimed invention, either expressly or inherently, such that a person of ordinary skill in the art could practice the invention without undue experimentation. See Atlas Powder

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Co. v. Ireco Inc., 190 F.3d 1342, 1347, 51 USPQ2d 1943, 1947
(Fed. Cir. 1999); In re Paulsen, 30 F.3d 1475, 1478-79, 31 USPQ2d
1671, 1673 (Fed. Cir. 1994).

After reviewing Murphy, we agree with Appellants' assertion that the marketing product from the marketing computer is not presented to the user concurrently during the time the financial transaction is carried out. Although the source of the marketing messages is the marketing computer, the data is sent to the terminal and stored on a hard disc associated with the terminal (col. 5, 20-25). Even when digitally transmitted data is sent to the terminal, the server/buffer 34 receives the data and redirects them to be stored on the hard disc 18 (col. 6, lines 36-39). As the terminal is used later, the stored data is displayed for the user during a holding or waiting period (col. 6, lines 39-45).

Therefore, what the Examiner characterizes in Murphy as a real time marketing to the user, is actually a stored data that is communicated to the user instead of the data obtained through a communication between the terminal and the marketing computer during the transaction done by the user on the terminal. The fact that telephone lines or co-axial cables may be used in Murphy does not change the arrangement related to storing the

marketing message on the storage disk of the terminal, as shown in Figure 1, where the storage hard disc is still needed.

In view of our analysis above, we find that Murphy does not teach all the limitations of claims 47, 51 and 55 and therefore, cannot prima facie anticipate the claimed subject matter. Accordingly, the 35 U.S.C. § 102 rejection of claims 47, 51 and 55 over Murphy is not sustained.

Turning now to the 35 U.S.C. § 103 rejection of claims 1-29, 31-34, 36-46, 48-50 and 52-54, we note that the Examiner finds that all the claimed limitations are taught by Murphy except for the step of selecting presentations in response to user data (answer, page 5). The examiner relies on Patterson for selecting presentations according to the customer information to modify Murphy so that appropriate display may be provided (id.).

Appellants argue that in Murphy the selection of the advertising message is determined by the message stored on the terminal hard disc (brief, page 17) whereas Patterson fails to cure the deficiencies of Murphy discussed above and with respect to steps c), e) and f), recited in claim 1 (brief, page 18). Appellants point out that Patterson uses only one host computer (18) for handling both the transaction and marketing message traffic (brief, sentence bridging pages 18-19).

The initial burden of establishing reasons for unpatentability rests on the examiner. In re Oetiker, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). Where, as here, a conclusion of obviousness is premised upon a combination of references, the examiner must identify a reason, suggestion, or motivation which would have led an inventor to combine those references. Pro-Mold & Tool Co. V. Great Lakes Plastics, Inc., 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1629, (Fed. Cir. 1996).

Although we recognize the Examiner's attempt to piece together a system that includes a marketing computer and a transaction computer with one that selects messages based on user data, as stated by Appellants (brief, page 18), there is no teaching or suggestion related to sending a request from the terminal to the marketing computer which selects a presentation to be sent back to the terminal. See In re Fritch, 972 F.2d 1260, 1266 n.14, 23 USPQ2d 1780, 1783-84 n.14 (Fed. Cir. 1992), "The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification."); Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988). As the court in Uniroyal, 837 F.2d at 1051, 5 USPQ2d at 1438 stated "it is

impermissible to use the claims as a frame and the prior art references as a mosaic to piece together a facsimile of the claimed invention" (citing W.L. Gore & Assoc., Inc. v. Garlock, Inc., 721 F.2d 1540, 1551, 220 USPQ 303, 312 (Fed. Cir. 1983)).

Here, the closest Patterson comes to suggesting the claimed subject matter is that the host computer 18 passes an instruction to the ATM terminal 10, allowing it to utilize the sales presentation storage means 16 to provide marketing presentation to the user (col. 2, lines 37-50). Beyond that, the Examiner has not explained how the instructions for selecting a presentation from one computer in Patterson, which controls both the transaction and the marketing requests, may be integrated into the system disclosed by Murphy where the terminal does not send any marketing request messages to the marketing computer. In that regard, we also agree with Appellants (brief, page 19) that both the transaction and selecting the presentation in Patterson are performed by the host computer 18 and Murphy has no need for selecting the presentations since they are already stored in the hard disc. Nonetheless, while Murphy's apparatus may be capable of being modified to select marketing presentations based on the user profile, there must be a suggestion or motivation in the references to do so. We see no such suggestion. Therefore, in

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view of the above analysis and the Examiner's failure to set forth a prima facie case of obviousness, the 35 U.S.C. § 103 rejection of claims 1-29, 31-34, 36-46, 48-50 and 52-54 is not sustained.

With respect to the rejection of claims 30 and 35, the Examiner further relies on Symonds for teaching the message format or layout (answer, pages 6-7). However, in discussing Symonds, the Examiner has pointed to no additional teaching that would have overcome the deficiencies of Murphy and Patterson as discussed above with respect to the other claims. Therefore, the 35 U.S.C. § 103 rejection of claims 30 and 35 over Murphy, Patterson and Symonds cannot be sustained.


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CONCLUSION

In view of the foregoing, the decision of the Examiner rejecting claims 47, 51 and 55 under 35 U.S.C. § 102 and of claims 1-46, 48-50 and 52-54 under 35 U.S.C. § 103 is reversed.

REVERSED


KENNETH W. HAIRSTON
Administrative Patent Judge


ERROL A. KRASS
Administrative Patent Judge

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MAHSHID D. SAADAT
Administrative Patent Judge

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